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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,488	09/16/2003	Joseph P. Errico	F-291	2425

530 7590 06/05/2007  
LERNER, DAVID, LITTENBERG,  
KRUMHOLZ & MENTLIK  
600 SOUTH AVENUE WEST  
WESTFIELD, NJ 07090

EXAMINER
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PELLEGRINO, BRIAN E

ART UNIT	PAPER NUMBER
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3738

MAIL DATE	DELIVERY MODE
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06/05/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/663,488

Applicant(s)

ERRICO ET AL.

Examiner

Brian E. Pellegrino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/23/07 has been entered.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the new limitation of the post being "permanently coupled with the manipulation tool" was not found in the written disclosure.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-13,15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

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which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The new limitation that the post is "permanently coupled" to the manipulation tool is unsupported by the disclosure. One of ordinary skill in the art understands "permanent" to mean affixed or joined without removal. The written disclosure does not recite that the post is joined or attached such that it cannot be removed. The new limitation is new matter.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-12 as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by Young et al. (6190414). Fig. 10 shows an intervertebral spacer device with first and second baseplates (**158,160**) that are mounted to one another via joint **162**. It can also be seen the baseplates include a plurality of engagement holes (**170,172**) in a perimetrical region that has a single post **140** positioned within the holes of the plates. The examiner is interpreting the claimed element "engagement hole" in this way: a cavity in something solid or an opening. Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974). See also *In re Morris*, Fed. Cir. 1997 127 F3d 1048, 1054,1055. The Examiner is also interpreting the "coupling" of the post with the tool as being accomplished via the gear mechanism and since it is within the slots of the distal end of

the tool, it is "permanent" and cannot be displaced in a lateral direction. Please note the intended use, as set forth in the claims, carries no weight in the absence of any distinguishing structure. Thus the spinal device is fully capable of having the desired surgical approach aspects. It can be seen that the post has a first position with a significant portion of the post within the tool and when cranked up to engage the plates to a second position, the post extends outward from the distal end to dispose within the engagement holes of the plates.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brantigan (5192327) in view of Rogers et al. (6709439). Brantigan discloses (Fig. 4) an intervertebral spacer device **17** with plates **11** having engagement holes **13**. Brantigan also shows (Figs. 13, 14) a manipulation tool with posts (**73, 75** respectively) that are inserted into the engagement holes via threads. However, Brantigan fails to disclose the tool has a spring to bias the post into the engagement hole. Rogers et al. teach (Fig. 7) a spring **64** loaded manipulation tool. Rogers also teaches that the spring is to maintain or keep the tip in the engagement hole, col. 8, lines 10-16. It would have been obvious to one of ordinary skill in the art to modify the means to maintain the post or tip

in the engagement hole and use a spring to hold the post in the hole as taught by Rogers et al. with the tool of Brantigan such that it makes it easier for the surgeon to attach to the implant.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brantigan '327 in view of Rogers et al. '439 as applied to claim 13 above, and further in view of Baccelli et al. (2003/2849). Brantigan in view of Rogers et al. is explained supra. However, Brantigan as modified by Rogers fail to teach a flange connected to the post. Baccelli et al. teach (Figs. 8,9) a flange **44** connected to the post for corresponding contour to better control manipulation or placement of the implant. It would have been an obvious expedient to one of ordinary skill in the art to incorporate the flange as taught by Baccelli et al. with the tool of Brantigan as modified by Rogers et al. such that it can be placed in the implantation site with enough force to stabilize the vertebrae.

### ***Response to Arguments***

Applicant's arguments filed 4/23/07 have been fully considered but they are not persuasive. In response to applicant's argument that the Young reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the entire post being within the manipulation tool) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988


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F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant's arguments with respect to claim 13 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Pellegrino whose telephone number is 571-272-4756. The examiner can normally be reached on Monday-Friday from 8am to 5pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TC 3700, AU 3738

  
**BRIAN E. PELLEGRINO**  
**PRIMARY EXAMINER**